

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim Amendments

In this response claims 22-24 are cancelled without disclaimer or prejudice. Claims 1-21 and 25-28 are maintained without amendment.

IDS

An IDS is submitted with this response. This IDS bring the attention of the PTO to references which were cited in a corresponding Japanese application. This IDS also brings the attention of the Examiner to United States Patent No. 6,724,491 and to the claims allowed therein. The references cited during the prosecution of United States Patent No. 6,724,491 are also included in the IDS.

Rejection under 35 USC § 112

The rejection of claim 23 under 35 USC § 112 second paragraph is rendered moot by the cancellation of this claim.

Rejections under 35 USC § 103(a)

- 1) The rejection of claims 1-2 and 25-27 under 35 USC § 103(a) as being unpatentable over Yoshii et al. (Yoshii) is respectfully traversed.

In connection with claim 1, the rejection acknowledges that Yoshii does not disclose a display data editing means but takes the position that it would be either "inherent or implied" inasmuch as Yoshii discloses a signal processing circuit 220 and a CCD imaging device 66B (Fig. 5) and alleges that "signal processing elements are often configured to edit images once captured from devices such as CCD cameras." In the alternative, the rejection purports that "if such element were not deemed inherent or implied, the addition [sic] image editing software to said system would have been commonly known in the art."

In a nutshell, the rejection acknowledges that the cited reference neither discloses nor suggests the claimed subject matter and is reliant on inherency or implication to provide the necessary gap closing guidance. The use of the term "often" in the rejection is seen as reducing the tenability of the rejection in that for something to be "inherent" it is required to happen each and every time, not just in some instances. The quasi admission that the inherency requirements are not always met, which is implied by the alternate position that if it were not inherent then it would have been commonly known, again renders the foundation of the rejection seriously shaky.

→ In further refutation, it is pointed out that the rejection correctly states that Yoshii does not disclose a display data editing means. Indeed, not only does Yoshii not disclose a display data editing means, it also fails to disclose displaying data on an image monitor per se.

The rejection alleges that it is known that signal-processing elements are often configured to edit images. Indeed, with devices such as such as a digital camera, image editing are often displayed to a user. However, the apparatus of Yoshii does not consider showing the images to an observer, and thus a nexus with an image monitor is not established. Therefore, there is no suggestion of editing the image data obtained in Yoshii.

It is therefore submitted that there is no disclosure from which a hypothetical person of ordinary skill could derive motivation to consider the purportedly obvious introduction of teachings which are either "inherent" or derived from "common knowledge." For at least this reason a *prima facie* case of obviousness has not been established.

That is to say, in order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

There are three possible sources for motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d

1453, 1457-58 (Fed. Cir. 1998) This case law, however, establishes that, even if the combination of the references may possibly teach every element of the claimed invention, without a motivation to combine, a rejection attempting to establish a *prima facie* case of obvious must be held improper. Additionally, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

To render the Applicant's position clear, it is submitted that the claimed subject matter is not directed merely to editing an image which is obtained from image data but is directed to an arrangement wherein the "data used from the time of obtaining the image until the time of computing the displacement" are edited and included in "display data for an image monitor."

It is submitted that this goes beyond merely editing obtained image data.

The fact that the present invention and the invention of Yoshii are patentably distinct can be understood by comparing the object (tasks to be achieved) and the means for achieving the task of the claimed subject matter and the subject matter disclosed in Yoshii.

The present invention focuses on a drawback encountered with the prior art, wherein "when the measured displacement turns out to be abnormal or when an unacceptable measurement result is obtained, it is not possible to distinguish for the user if it is due to the abnormal condition of the object or due to the abnormal operation of the sensor, possibly due to the influences of exterior light or the like" (P. 2, lines 13-16 of the specification (or paragraph [0007] of the publication)).

Yoshii also focuses on occurrence of error due to slanting of the wafer surface (measurement object), in other words, a type of malfunction of the sensor, as shown in figure 17. However, Yoshii does not display the "data used from the time of obtaining the image until the time of computing the displacement" as required by the claimed subject matter, but detects occurrence of errors by providing a two dimensional sensor 219 where the image of stop 225 is formed, separately from the two dimensional sensor 218 where the image of the wafer surface is formed. Thus, while Yoshii focuses on a similar task problem as the present invention, Yoshii employs a distinctively different means for achieving the task.

It is submitted that the subject matter of claim 1 is not rendered unpatentable for at least this reason also. It is submitted that independent claim 25 is also patentable in view of Yoshii for the same reasons as advanced above.

- 2) The rejection of claim 21 under 35 USC § 103(a) as being unpatentable over Yoshii in view of Bonnefous is respectfully traversed. This rejection inherits the shortcoming pointed out above wherein the teachings of Yoshii are insufficient to enable a *prima facie* case of obviousness for the claim from which claim 21 depends.
- 3) The rejection of claim 28 under 35 USC § 103(a) as being unpatentable over Yoshii in view of Dong is respectfully traversed. This rejection also inherits the shortcoming pointed out above wherein the teachings of Yoshii are insufficient to enable a *prima facie* case of obviousness for claim 25 from which claim 28 depends.

Allowable Subject Matter

The indication that claims 2-20 and 24 contain allowable subject matter is noted with appreciation. However, it is noted that claim 2 has also been rejected – see second paragraph on page 3 of this Office Action. While this appears to a simply typographical error, it does appear to warrant clarification. In the interim, it is submitted that it is premature to consider rewriting claims into independent form in light of the arguments advanced above in connection with the patentability of claims 1 and 25.

Conclusion

It is submitted that all of the claims which remain pending in this application are allowable over the art for at least the reasons advanced above. Favorable reconsideration and allowance of this application is courteously solicited.

Respectfully submitted,

By

Date May 24, 2004

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